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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/321,882 05/28/99 UPASANI

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EXAMINER

RADIO, B
ART UNIT

PAPER NUMBER

1616
DATE MAILED:

03/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/321,882

Applicant(s)
Upasani et al.

Examiner
Barbara Badio

Group Art Unit
1616

☐ Responsive to communication(s) filed on _____.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 25-27, 46, 55, 57-59, and 61-67 is/are pending in the application.

Of the above, claim(s) 63, 66, and 67 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 25-27, 46, 55, 57-59, 61, 62, 64, and 65 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Second Final Action on the Merits

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

- w) 3. **The rejection of claims 25-27, 46, 55, 57, 59 and 62 under 35 USC 103(a) over Gee et al. (WO 94/27608) is maintained.**


Applicant argues that the reference teaches away from the claimed invention when taken as a whole. Applicant also argues that alkylene homologs of the prior art compound are not included in the genus recited by the claimed invention. Applicant's argument was considered but not persuasive for the following reasons.

The reference teaches R can be hydrogen, alkyl, alkynyl, trihaloalkyl, monohaloalkyl, alkenyl and aralkyl (see page 11, lines 9-15). The reference also teaches that "[a] preferred group of compounds include those in which **R is not hydrogen...**" (see page 12, lines 5-6). Another preferred group of compounds are those cited by applicant. It is noted, however, that said group does not include

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compounds wherein R is hydrogen. According to page 12, lines 14-16, R is lower alkyl or trihalo(lower)alkyl. Even if one agrees that R is hydrogen in said group, the preceding paragraph and the first two paragraphs on page 13 teach R is preferably not hydrogen. Therefore, the reference provides sufficient guidance/direction to modify the exemplified compounds, including 3 α -hydroxy-21(pyrid-4-ylthio)-5 β -prenan-20-one, making compounds wherein R is not hydrogen but groups such as lower alkynyl or trihalo(lower)alkyl groups as recited by the instant claims.

For these reasons and those given in Paper No. 13, the rejection of claims 25-27, 46, 55, 57, 59 and 62 under 35 USC 103(a) over Gee et al. (WO 94/27608) is maintained.

 4. **The rejection of claims 25-27, 46, 55, 57-59, 61 and 64-65 under 35 USC 103(a) over Bolger et al. ('917) is maintained.**

Applicant argument is based on the decision made in *In re Baird*. According to applicant none of the exemplified prior art compounds have the 17 β -C(O)-CH₂-O-R16 as claimed by the present invention. Applicant's argument was considered but not persuasive for the following reasons.

Unlike, *In re Baird*, the claimed invention, like the prior art, is drawn to a vast number of compounds and, thus, the decision of Baird does not apply. One has to look at the prior art as a whole and what it teaches the ordinary artisan. The reference

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teaches and exemplifies compounds having $17\beta\text{-C(O)-CH}_2\text{-O-C(O)R16}$ and an equivalence between O-C(O)R16 and O-R16 . The reference also teaches an equivalence between alkyl, aryl and heterocyclic groups. Thus, the modification of the exemplified compounds having $17\beta\text{-C(O)-CH}_2\text{-O-C(O)R16}$ with a group having $17\beta\text{-C(O)-CH}_2\text{-O-R16}$ wherein R16 is aryl or a heterocyclic group is prima facie obvious.

For these reasons and those given in Paper No. 13, the rejection of claims 25-27, 46, 55, 57-59, 61 and 64-65 under 35 USC 103(a) over Bolger et al. ('917) is maintained.

Telephone Inquiry Contacts

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


BARBARA P. BADIO, PH.D
PRIMARY EXAMINER

March 5, 2001